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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,005	01/20/2004	Yoshitaka Sasaki	247889US0X	6848

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EXAMINER	
HEINZ, ALLEN J	

ART UNIT	PAPER NUMBER
2653	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/759,005	SASAKI ET AL.	
	Examiner	Art Unit	
	A. J. HEINZ	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) *19-23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/20/04; 8/31/04;*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: *ADDENDUM A*.

1. Applicant's election, with traverse, of the Group II invention[Cls.1-18] in Paper dated 9/28/05 is acknowledged. The traversal is on the ground(s) that there has not been shown sufficient evidence to support the restriction requirement and that there is no significant burden for the examiner to examine both inventions.

This is not found to be persuasive because to the first allegation, the examiner has set forth evidence to the extent that in this art area it is well known that process claims to the manufacture of thin film magnetic heads is different than those of the apparatus as shown by the classification [class 360 vs. class 29] for the different groupings. Since this has always been one of the acceptable tests to support restriction between different claim grouping, applicant's argument is flawed and therefore not persuasive

And to the second contest, i.e. there exists sufficient commonality in the subject of both the apparatus and method claims that there would be no significant burden for the examiner to examine both inventions, this is not found to be persuasive because the applicant has failed to provide substantive evidence showing, for example, that searching the additional varied and complex processes classified in class 29,

when it is not required for the apparatus, would not place a greater burden upon the examiner.

Claims 19-23 are therefore withdrawn from further consideration by the examiner, pursuant 37 CFR 1.142(b), as being drawn to a non-elected invention.

It is further indicated that applicant is indeed correct with regard to rejoinder of the apparatus and process claims, provided that the non-examined process claims "include all of the limitations of the allowable product claims".

The requirement is still deemed proper and is therefore made FINAL.

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The Title should provide a more detailed structural identification of the feature or features which distinguish the invention from the prior art.

The portion of the Title directed to the method should also be deleted.

3. Claims 1-18 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point

out and distinctly claim the subject matter which applicant regards as the invention.

The following phrases lack clear antecedent basis within the claim(claims); i.e. either the particularly recited passage fails to be properly introduced prior to its appearance at that point in the claim or the structure recited in the passage is not an inherent part of or component of other previously recited structure: claim 1: "the top surface"(line 11), "the height" (e.g. line 13) and "the pole length"(line 18); claim 10: "its upper end" (line 8), "the upper end"(e.g. line 13), "the top surface"(line 15), "the height"(e.g. line 18), "said one surface of the upper yoke"(line 21), "the pole length"(line 23) and "the height of the lower pole and the height of the upper pole"(line 24).

An exhaustive search of indefinite and/or ambiguous language has not been attempted, but only exemplified in the preceding paragraphs. Therefore the applicant is responsible for a thorough review of all the claims to make corrections as appropriate.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-18 are rejected under 35 U.S.C. §102(e) as being anticipated by Tagawa.

See Figures 3&4. Note, to the extent claimed and understood, the structure as shown in Addendum A reads on and performs to the same degree as claimed.

6. For a complete response applicant should identify how the claimed structure of his invention defines over ***all*** the art of record.

Moreover, where the applicant disagrees with the reasoning and/or application of the prior art on critical points of the claims, they should identify how the claimed structure of their invention defines over ***all*** the art of record not just the applied art.

Where applicant believes that the art is redundant and/or superfluous relative to the critical aspects of the claimed invention the applicant may simply state so in rebuttal summary.

7. If applicant has filed an information disclosure statement and this instant office action does *not* contain an initialed-off copy (or copies) of all such filed IDS's (or at least a comment to the disposition of such IDS'S in the body of the office action itself) applicant should apprise the examiner of such missing documentation [to the IDS's] in response to this office action so that the examiner can take appropriate action to supply same to the applicant.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. J. HEINZ whose telephone number is (571) 272-7587. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM KORZUCH can be reached on (571)272-7589.

The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. J. HEINZ
Primary Examiner
Art Unit 2653



Addendum A

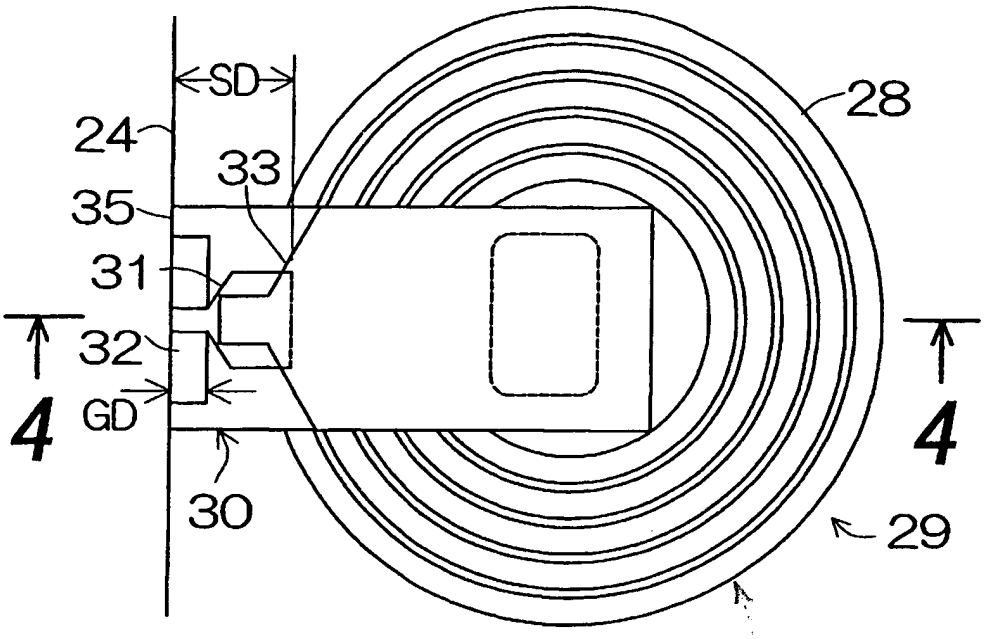


FIG.3

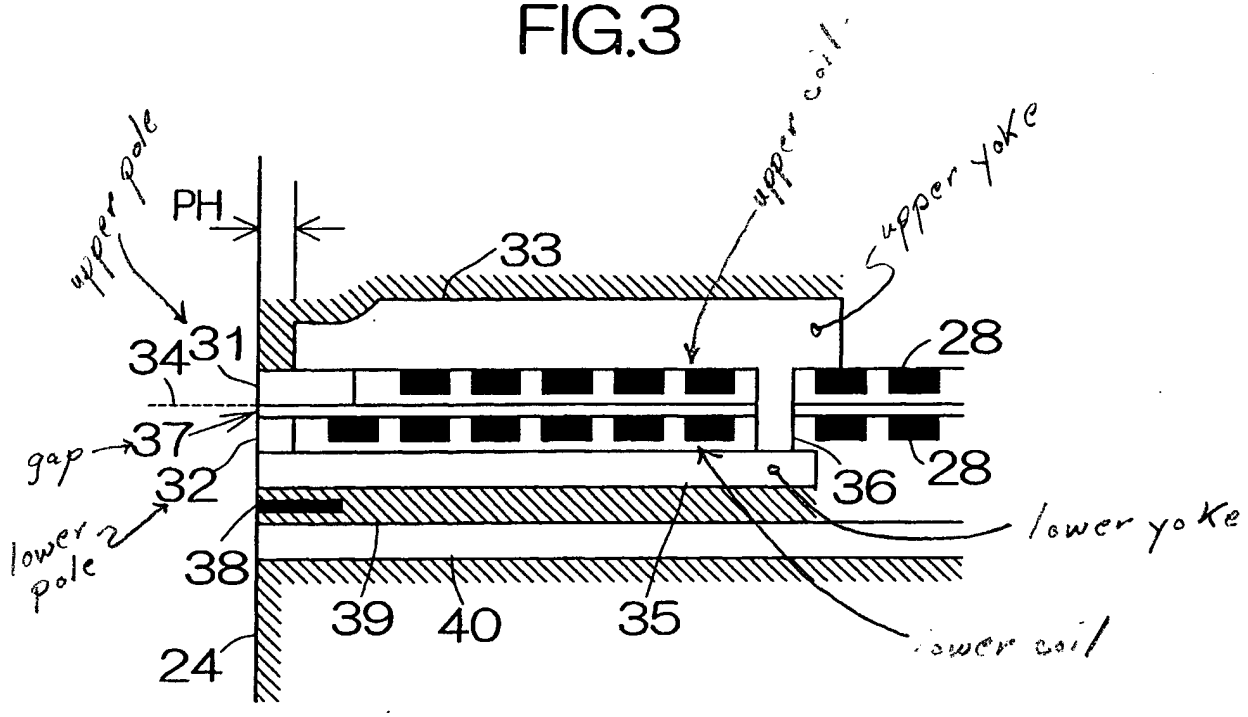


FIG.4